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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/083,338	02/27/2002	Tomohiro Yasuda	HIRA.0027	8246
38327	7590	01/21/2005	EXAMINER	
REED SMITH LLP			MAHATAN, CHANNING	
3110 FAIRVIEW PARK DRIVE, SUITE 1400			ART UNIT	
FALLS CHURCH, VA 22042			PAPER NUMBER	

1631

DATE MAILED: 01/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

10/083,338

Applicant(s)

YASUDA ET AL.

Examiner

Channing S Mahatan

Art Unit

1631

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 07 December 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY [check either a) or b)]**

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☒ they raise the issue of new matter (see Note below);
- (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: 1-15.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

8. ☐ The drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☐ Other: \_\_\_\_\_

C. Ma / f  
January 18, 2005

Continuation of 2. NOTE: The amendment of the limitation "high speed algorithm" would raise the rejection under 35 U.S.C. 112 2<sup>nd</sup> Paragraph 'Vague and Indefinite' and/or 'Improper Incorporation by Reference'. Additionally, pointed support (page 14-15) for the amendment to claim 12 "any entry in said table is removed if a number of entries sharing an identical key therein is more than a previously specified number" appears to be absent and thus would result in a 35 U.S.C. 112 1st Paragraph Rejection 'New Matter'. Thus, the amendment filed 07 December 2004 would raise the issue of new matter and would raise new issues requiring further consideration and/or prior art search.

Continuation of 5. does NOT place the application in condition for allowance because: the proposed amendments filed 07 December 2004 have not been entered for the reasons in Box 2 and Applicants arguments directed toward the rejections under 35 U.S.C. 112 1<sup>st</sup> and 2<sup>nd</sup> Paragraph are found unpersuasive. In addressing the rejection under 35 U.S.C. 112 1st Paragraph Rejection 'Lack of Enablement' Applicants appear to be arguing, in conjunction with the stated Zhang article, limitations not found in either the specification or instant claims. Applicants have indicated (page 11, lines 27-31 of the 'Response') regarding the rejection of missing essential steps that "counting a number of different nucleic acid bases thereof via a high speed algorithm" and "if the number of different nucleic acid bases of the second nucleic acid base sequence and the first nucleic acid base sequence is smaller than a value determined by an user" are being added to claims 1, 3, 5 in order to overcome this rejection. However, no such amendment has been submitted. Finally, the limitations "fixed-length partial sequence" and "sufficiently similar" remain vague and indefinite in view of Applicants arguments (page 11, lines 18-26 of the 'Response') because said claim language implies a range or criteria defining the "fixed length partial sequene" and degree/criteria considered to be "sufficiently similar". Therefore, the amendment will not be entered and the rejections (Office Action mailed 07 September 2004) are maintained for reasons of record.

 1/18/05  
ARDIN H. MARSCHEL  
PRIMARY EXAMINER